

REMARKS

SUMMARY

Reconsideration of the application is respectfully requested.

Claims 3-21 are in the application. Claims 3-17 have been rejected by the Examiner. Claims 18-21 have been objected to. Claims 1 and 2 have been previously cancelled.

Applicants appreciatively acknowledge the Examiner's consideration of Applicants' arguments made in Applicants' Response of November 7, 2005.

Additionally, Applicants respectfully request clarification regarding the status of claims 18-21. In the Examiner's "Response to Arguments" item 4 on page 2 of the final Office Action, the Examiner objects to claims 18-21 as containing novel material. However, in "Allowable Subject Matter" on page 8, the Examiner states that claims 18-21 would be allowable if rewritten in independent form. Thus, Applicants respectfully request clarification regarding the nature and scope of the Examiner's objection(s).

Allowable Subject Matter

Claims 18-21 have been objected to as depending upon rejected base claims. The Examiner suggests that if claims 18-21 were amended to recite the limitations of the rejected base claims, claims 18-21 would be allowable. While Applicants appreciate the Examiner's finding of allowable subject matter, Applicants maintain that all of the pending claims are allowable in their current form.

Double Patenting

In "Double Patenting," on page 3 of the above-identified final Office Action, claims 3-21 have been *provisionally* rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/705,763 (hereinafter '763) which was filed on the same day as the instant application and is owned by the same entity. Applicants respectfully traverse as the claims of '763 fail to recite or suggest a parameter processing module as is claimed in independent claims 3, 7, 11, and 15.

When a double patenting rejection is appropriate, it must be based either on statutory grounds or nonstatutory grounds. The ground of rejection employed depends upon the relationship of the inventions being claimed. In the instant case, the above-identified Office Action indicates that a provisional nonstatutory obviousness-type double patenting rejection is being asserted. '763 is improperly identified as possessing conflicting claims, which are not identical, but are allegedly not patentably distinct from the claims of the instant application.

Obviousness-type double patenting should only reject application claims when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000). In the instant case, the claims of '763 fail to recite or suggest a parameter processing module as is claimed in independent claims 3, 7, 11, and 15. Withdrawal of the provisional rejection is respectfully requested.

Should the Examiner determine that the claims of the present invention and those of '763 are "not patentably distinct" as asserted by the Applicants, the Applicants will, upon issuance of either '763 or the instant application, submit the necessary Terminal Disclaimer for the remaining application. Thus, there will be no double patenting.

Claim Rejections - 35 U.S.C. § 103

To establish obviousness under 35 U.S.C. § 103, the Examiner must view the invention as a whole. Further, the Examiner is to perform the obviousness analysis in accordance with the standard set forth by the Supreme Court in *Graham v. John Deere Co.* That standard requires that the Examiner (1) determine the scope and content of the prior art; (2) ascertain the differences between the prior art and the claims in issue; (3) resolve the level of ordinary skill in the art; and (4) evaluate evidence of secondary considerations. 383 U.S. 1, 17-18 (1966); *see also* MPEP 2141. Secondary considerations include whether the invention met with commercial success, whether the invention answered a long felt need, and whether others attempting the invention have failed. *Graham*, 383 U.S. at 17-18. Further, in applying the *Graham* framework,

the Examiner must consider the invention as a whole, without the benefit of hindsight. MPEP 2141.

1. In “Claim Rejections – 35 USC § 103,” on page 4 of the above-identified final Office Action, claims 3-4, 6-8, 10-12, and 14-17 have been rejected as being unpatentable over U.S. Patent Application No. 09/792,810 to *Shapiro et al.* (hereinafter “Shapiro”) in view of U.S. Patent Application No. 10/164,187 to *Fischer et al.* (hereinafter “Fischer”) and U.S. Patent No. 6,216,173 to *Jones et al.* (hereinafter “Jones”) under 35 U.S.C. § 103(a).

Claim 3 recites a computer system comprising:

“a processor; and

memory coupled to the processor having a plurality of programming instructions implementing a programming interface layer for a service provider to facilitate delivery of data services to client devices by any of a plurality of vendors via the service provider, the programming interface layer including

a plurality of generic executable service functions callable by any of the plurality of vendors to facilitate delivery of a plurality of heterogeneous data services;

a parameter processing module for processing function-specific parameters, including device information for a wireless mobile device, for one of said plurality of generic executable service functions wherein said function-specific parameters are associated with one of said generic executable service functions; and

a response generating module for generating a function-specific response from one of said generic executable service functions, wherein said function-specific response is associated with one of said generic executable service functions and includes said device information.”

None of the cited references, alone or in combination, teaches “a plurality of generic executable service functions callable by any of the plurality of vendors to facilitate delivery of a plurality of heterogeneous data services,” as is claimed in claim 3 of the present invention.

In contrast, Shapiro teaches a “system and method for automatically creating information useable to access functionality of a backend computer system coupled to an application server.”

Neither the backend computer system, nor the application server, nor the optional web server facilitating communication between clients and application servers has a programming interface layer which includes “a plurality of generic executable service functions callable by any of the plurality of vendors to facilitate delivery of a plurality of heterogeneous data services.” Shapiro further discusses the prior art use of CGI scripts by users to access information in a database. Even assuming *arguendo* that the CGI Script functions read on “generic executable service functions” (a point in which Applicants do not concur), nothing in Shapiro remotely suggests the use by vendors of the script functions to deliver a plurality of heterogeneous data services. Such language is neither expressly nor inherently found in Shapiro.

Fischer, both alone and in combination with Shapiro, fails to cure the defects of Shapiro. Fischer teaches an “application programming interface [(API)] layer for devices, such as handheld computers, personal digital assistants (PDAs), Internet enabled phones, laptops, and desktop computers or the like, that provides device independence so applications may run on any of such devices without specific programming for device specific dependencies.” While the API layer of Fischer arguably reads on a programming interface layer, the API of Fischer fails to disclose anything resembling generic executable service functions that facilitate delivery of a plurality of heterogeneous data services.

Even taking Shapiro, Fischer, and Jones as a whole, the cited prior art fails to make obvious the present invention as claimed in claim 3 when the invention as claimed in claim 3 is viewed as a whole. Jones offers a “method and apparatus for incorporating content processing and content routing intelligence into networks.” While Jones teaches function calls passed between content processing and routing services, it makes no reference to whether such function calls are to generic executable service functions of a programming interface layer. Thus, viewing the present invention as claimed in claim 3 as a whole, the cited references fail to render the claim unpatentable.

Accordingly, claim 3 is patentable over Shapiro, Fischer, and Jones, alone, in combination, or in sub-combination.

Claims 7, 11, and 15 recite similar limitations to the present invention as claimed in claim 3. Accordingly, for at least the same reasons, claims 7, 11, and 15 are patentable over Shapiro, Fischer, and Jones, alone, in combination, or in sub-combination.

Claims 4, 6, 8, 10, 12, 14, and 16-17 depend from claims 3, 7, 11, and 15, respectively, incorporating their limitations correspondingly. Accordingly, for at least the same reasons, claims 2, 4, 6, 8, 10, 12, 14, and 16-17 are patentable over the cited art.

2. In “Claim Rejections – 35 USC § 103,” on page 7 of the above-identified final Office Action, claims 5, 9, and 13 have been rejected as being unpatentable over Shapiro, Fischer, and Jones, and further in view of U.S. Patent Application No. 10/066,841 to *Wookey et al.* (hereinafter “Wookey”) and U.S. Patent Application No. 09/733,540 to *Wray* (hereinafter “Wray”) under 35 U.S.C. § 103(a).

As stated above, Shapiro, Fischer, and Jones, individually or combined, fail to disclose required, recited operations of the present invention, as claimed in claims 3, 7, and 11. Thus, even when combined with Wookey and/or Wray, the cited art fails to show novel features that are noted when the invention of claims 3, 7, and 11 is viewed as a whole. Consequently, claims 5, 9, and 13 are patentable over the combination of Shapiro, Fischer, Jones, Wookey, and Wray.

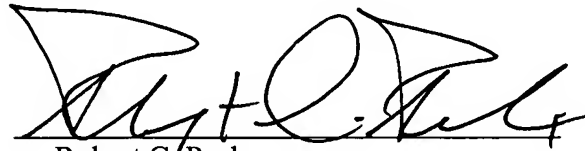
Conclusion

Applicant submits that all pending claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1513. If any fees are due in connection with this paper, the Commissioner is authorized to charge Deposit Account 500393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

Date: January 3, 2005

by:

A handwritten signature in black ink, appearing to read 'R. C. Peck', written over a horizontal line.

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